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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,401	03/01/2002	Gregory P. Fitzpatrick	BOC920010011	1337

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EXAMINER	
SCHUBERT, KEVIN R	

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/086,401	FITZPATRICK ET AL.	
	Examiner	Art Unit	
	Kevin Schubert	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-22 have been considered.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/6/06 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the phrase "extremely unlikely" renders the claim indefinite, as a definitive standard for ascertaining its term of degree is not found in the claims or specification. Appropriate correction is required.

Claims 3-5 are rejected based on lack of antecedent basis. Claim 3 recites the limitations "said processing subsystem" and "said storage subsystem". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson, U.S. Patent No. 2003/0163718.

As per claims 1 and 22, the Applicant describes a system comprising the following limitations which are met by Johnson:

a) an array of multiple stores and logic for randomly dispersing successive granular portions of data in said set into said stores, each said granular portion containing only information of a non-sensitive nature, wherein each granular portion has a smaller bit size than said set, and wherein said set is able to be reassembled from the granular portions by concatenating retrieved granular portions to one another in an original order ([0051]-[0054] and [0104]-[0107]);

b) whereby extraction of sensitive information in said data set from unauthorized access to data contained in said stores is extremely unlikely ([0051]-[0054] and [0104]-[0107]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2,6,8,9,11,13,17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Mason, U.S. Patent No. 5,981,946, in further view of Hsieh, U.S. Patent Application Publication No. 2001/0041012.

As per claims 2,6,8,11,13,17, and 20, the Applicant describes the system in accordance with claims 1 (etc), which is met by Johnson, with the following limitations:

a) Logic to transfer successive granular portions into randomly selected block queues in an array of multiple block queues (Hsieh: [0036]; Mason: Col 12, lines 56-58);

b) each block queue holding multiple granular portions (Mason: Col 12, lines 56-58);

c) logic to detect when any of said block queues becomes filled (Mason: Col 12, lines 56-58);

d) contents of each said filled block queue having only non-sensitive information (Mason: Col 12, lines 56-58);

e) and logic responsive to detection that a said block queue has become filled to transfer contents of the respective filled block queues to a randomly selected one of said stores in said array of stores (Mason: Col 12, lines 56-58);

Johnson discloses all the limitations of claim 1. Johnson also teaches that software may read data into a register queue (and perhaps perform functions on the data) and write the data to another location. However, Johnson does not appear to teach monitoring when register queues are full. Mason teaches a system in which data is maintained in register queues. When the register queues are full, the data may be transferred to another location. Combining the ideas of Mason with those of Johnson allows the data to be transferred when a queue is full. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Mason with those of Johnson because doing so ensures that data in a register queue will be transferred at an appropriate time and that data in a register queue that has not yet been transferred will not be rewritten over.

Johnson in view of Mason disclose all the limitations of the above claim, except the limitation of storing data randomly in one of a number of queues. Hsieh discloses the well idea of storing data randomly in one of a number of queues. It would have been obvious to one of ordinary skill in the art at

the time the invention was filed to combine the ideas of Hsieh with those of Johnson and store data randomly in one of a number of queues because doing so increases security in the system by adding further randomness to the system.

As per claims 9 and 19, the Applicant describes a system in accordance with claims 6 and 17, which are met by Johnson in view of Mason in further view of Hsieh, with the following limitation:

Wherein said data set is in the form of a table having rows and columns, said dispersed portions are located originally at intersections of said rows and columns, and said retained metadata includes information for repositioning retrieved granular portions of said data set into specific row and column intersects of said table at which said portions were originally located prior to their dispersal into said stores;

Johnson in view of Mason in further view of Hsieh teach a data set. However, Johnson in view of Mason in further view of Hsieh appear to fail to teach that the data set may be in table form (having rows and columns). Examiner takes official notice that it is well-known in the art to have data in table form. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to have data in a table form because table form is a well-known method of storing/presenting data in an organized fashion.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Dickinson, U.S. Patent No. 6,853,988.

As per claims 3-5, the Applicant describes the system of claim 1, which is met by Johnson, with the following limitation which is met by Dickinson:

Wherein said processing subsystem is connected to said storage subsystem through a data communication network (Dickinson: Col 2, lines 55-56; Col 6, lines 15-16; Col 6, lines 49-51; Col 9, line 1);

Johnson teaches all the limitations of claim 1. However, Johnson appears to fail to disclose that data is stored via a network. Dickinson discloses the well-known idea that data may be stored via a network. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Dickinson with those of Johnson and store data via a network for at least the reason that doing so may increases storage capability (and thus amount of data which may be stored) by allowing for storing data externally in one or more additional systems.

Claims 7,10, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Mason in further view of Hsieh in further view of Schneier (Schneier, Bruce. Applied Cryptography. John Wiley & Sons. 1996. pages 1-5).

As per claims 7,10, and 18, the Applicant describes the system in accordance with claims 6 and 17, which are met by Johnson in view of Mason in further view of Hsieh, with the following limitation:

Wherein said retained metadata is enciphered and said logic for using said metadata to retrieve said granular portions includes logic for deciphering said retained metadata (Schneier: pages 1-5);

Johnson in view of Mason in further view of Hsieh teach all the limitations of claims 6 and 17. Further, Johnson in view of Mason teach metadata and logic. However, Johnson in view of Mason in further view of Hsieh appear to be silent as to *encrypting* the metadata and logic. Schneier teaches the well-known idea that encryption may increase security in a system. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the idea of encryption taught by Schneier with those of Johnson in view of Mason in further view of Hsieh because encryption may increase security in the system.

Claims 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Mason in further view of Hsieh in further view of Hickman, U.S. Patent No. 6,523,130.

As per claims 12 and 21, the Applicant describes the system of claims 6 and 13, which are met by Johnson in view of Mason in further view of Hsieh, with the following limitation:

Wherein each said filled block is stored in plural selected ones of said stores in said array of stores; whereby failure of any one of said plural stores would not prevent retrieval of the respected filled block (Hickman: Col 8, lines 10-11);

Johnson in view of Mason in further view of Hsieh teach all the limitations of claims 6 and 13. However, Johnson in view of Mason in further view of Hsieh appear to be silent as to storing data redundantly. Hickman teaches the well-known idea of storing data redundantly. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Hickman with those of Johnson in view of Mason in further view of Hsieh and store data redundantly because doing so makes the system more robust by allowing for data backup.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Mason in further view of Hsieh in further view of Dickinson.

As per claims 14-16, the Applicant describes the method of claim 13, which is met by Johnson in view of Mason in further view of Hsieh with the following limitation:

Wherein transferal of said full block queues to said stores is performed through a data communication network (Dickinson: Col 2, lines 55-56; Col 6, lines 15-16; Col 6, lines 49-51; Col 9, line 1);

Johnson in view of Mason in further view of Hsieh teach all the limitations of claim 1. However, Johnson in view of Mason in further view of Hsieh appear to fail to disclose that data is stored via a network. Dickinson discloses the well-known idea that data may be stored via a network. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Dickinson with those of Johnson in view of Mason in further view of Hsieh and store data via a network for at least the reason that doing so may increases storage capability (and thus amount of data which may be stored) by allowing for storing data externally in one or more additional systems.

Response to Arguments

Applicant's arguments, see Remarks 6/6/06, with respect to the prior art rejections of claims 1-22 presented in the previous action are moot in view of the new ground(s) of rejection.

Applicant's argument with respect to the 131 references antedating the Johnson reference have been fully considered, but they are not persuasive. Applicant appears to attempt to antedate the reference by showing conception plus due diligence. The examiner respectfully notes that the foregoing doesn't overcome the rejection for at least the three reasons that the Declarations 1) merely recite a general allegation of patentability, 2) do not provide a sufficient showing of diligence 3) do not show the complete claimed invention.

1. General Allegation of Patentability

"A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of the conclusion is insufficient to satisfy 37 CFR 1.131" (MPEP 715.07).

"The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits described a reduction to practice "amounts essentially to mere pleading, unsupported by proof or showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). **Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant**" (MPEP 715.07).

Applicant's mere submission of a 131 Declaration along with a general allegation of patentability is insufficient. The applicant provides no explanation as to how the Declarations support conception of the claimed invention.

2. No sufficient showing of diligence

"Where conception occurs prior to the date of the reference, but reduction to practice is

afterward, it is not enough merely to allege that applicant or patent owner had been diligent" (MPEP 715.07 a)

The applicant states that the "applicants further exercised due diligence from prior to the effective date of Johnson to March 1, 2002, the date the present application was filed" (Remarks: page 2). Applicant further states that a review of the Disclosure took place on March 16, 2001, an initial novelty search was requested on April 2, 2001, the final search results were received on April 27, 2001, and a final decision to proceed with filing of the instant application and the application was assigned to outside counsel on April 30, 2001 (Remarks: page 3). Apparently, the outside counsel prepared the case it received on April 30, 2001 and filed the case with the USPTO as of the effective filing date March 1, 2002.

Examiner respectfully, but most strenuously, disagrees that a sufficient showing of diligence has been shown. The critical date in which due diligence need be shown is just prior to the reference to constructive or actual reduction to practice. In the instant case, this critical period is April 11, 2001 to March 1, 2002. Applicant's sparse detail in exhibiting due diligence, including an *entire 10 month* period from April 30 to March 1, 2002 in which no detail other than a general statement that outside counsel was preparing the application (emphasis added), does not provide a sufficient showing that due diligence has been exercised. Examiner further notes that the courts have held diligence to a strict standard, nowhere near the foregoing. (See for example *In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed Cir. 1983).* In this case the court ruled that a two-day time period was enough to show lack of diligence.)

3. Do Not Show the Complete Claimed Invention

It appears that the Declarations do not show the complete claimed invention. For example, the Declarations do not appear to show "*randomly* dispersing successive granular portions" (see claim 1, line 3, and claim 22). Further, Examiner fails to find any of the limitations of claim 2 (this apparently deficient subject matter is also present in claim 13). Examiner also fails to find the limitation of claim 7 "wherein said retained metadata is enciphered and said logic for using said metadata to retrieve said granular

portions includes logic for deciphering said retained metadata". Examiner notes that the above is not a comprehensive list and that other deficiencies may be present.

Conclusion

This action is non-final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KS

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER